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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ANDREW BENNY, PHILIPPE COMPAIN, ALAN PAUL
PICKERSGILL, STEPHEN WILLIAM NEKOLAICHUK, ROBERT J.
SIMMONS, and CHRIS EDWARD TERRY

Appeal 2009-001260
Application 09/876,090
Technology Center 2400

Decided: May 28, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and
ST. JOHN, COUTERNAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appeal 2009-001260
Application 09/876,090

The Appellants appeal under 35 U.S.C. § 134(a) from the Final rejection of claims 22-25. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm-In-Part.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and a program for creating a technical delivery framework to manage information technology systems (Spec. 1).

The Illustrative Claim

Claim 22, an illustrative claim, reads as follows:

22. A method for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising the steps of:

determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services;

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities;

creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components; and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer.

The Reference

The Examiner relies on the following reference as evidence:

Hill US 6,670,973 B1 Dec. 30, 2003

The Rejections

The following rejections are before us for review:

Claims 23-24 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Claims 22-25 stand rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of the copending Application No. 09/875,863¹ or claims 25-30 of the copending Application No. 09/875,865².

Claims 22-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hill.

¹ The copending Application No. 09/875,863 is now US 7,389,217. The allowed claims are the substantially same as those in the copending application.

² The copending Application No. 09/875,865 is now US 7,487,079.

II. ISSUES

1. Has the Examiner erred in finding that the technical framework recited in claim 23 and a computer program product recited in claim 24 are not patent-eligible subject under 35 U.S.C. § 101³?

2. Has the Examiner erred in identifying that claims 22-25 stand rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/875,863 of claims 25-30 of the copending Application No. 09/875,865?

3. Has that the Examiner erred in finding that Hill discloses the limitations “determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services” as recited in claim 22?

III. PRINCIPLES OF LAW

Anticipation

“[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim” *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). “[A]bsence from the reference of any claimed element negates

³ The rejection of claim 22 under 35 U.S.C. § 101 has been expressly withdrawn by the Examiner (Ans. 10).

anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed.Cir. 2004). In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

35 U.S.C. § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101.

Nonstatutory Obviousness-type Double Patenting

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See e.g., In re Berg*, 140 F.3d 1428 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985).

IV. FINDING OF FACT

The following finding of fact (FF) is supported by a preponderance of the evidence.

The Hill reference

1. Hill discloses a method and a computer program as a tool for representing the information technology (IT) infrastructure of an organization as a hierarchical list and graph (Abstract). The elements of the hierarchical list and graph can be added and deleted. The relationship between the elements of the hierarchical list and graph can be modified (col. 2, ll. 1-29).

V. ANALYSIS

The Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to Appellants' Briefs to show error therein. *Id.*

The Common Feature in the Claims

Independent claim 22, recites, *inter alia*, “determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services.” Independent claims 23-25 contain similar recitations of these limitations.

35 U.S.C. § 101 Rejection

Claim 23

With respect to claim 23, the Appellants contend that claim 23 is directed to a useful and tangible result, namely creating a technical framework or use in delivering a specific set of IT services for a customer (App. Br. 10). According to the Appellants, claim 23 is not directed to an abstract idea, a law of nature or a natural phenomenon. Rather, “[i]t does have substantial practical application, namely, providing a way for . . . outsourcing services from one client to the next.” (Reply Br. 3). In addition, the framework as claimed typically identifies how those parts fit together at the highest level and “is not an abstract idea as asserted by the Examiner.” *Id.* Finally, the Appellants contend that the Examiner does not cite any legal authority to support his position and provide any evidence that any of limitations of claim 23 can be performed by a person. *Id.*

We disagree with the Appellants’ contentions. “An idea of itself is not patentable.” *Diamond v. Diehr*, 450 U.S. 175, 185 (1981) (quoting *Rubber-*

Tip Pencil Co. v. Howard, 87 U.S. (20 Wall.) 498, 507 (1874); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) (“[M]ental processes, and abstract intellectual concepts are not patentable.”); *see also id.* at 71 (“It is conceded that one may not patent an idea.”). The body of claim 23 recites “*a solution scope* determined for the technical framework . . . *a mapping* of the customer’s existing equipment to lowest level abstractions of architectural building blocks . . . *a list of design objects* created as a function of the solution scope . . . *designated relationships* between the design objects . . . *a detailed technical design* developed for the information technology . . .” (Emphasis added). The technical framework with all the steps can certainly be written on a paper with a pencil by a person (e.g. summary for a brainstorm meeting of a technical team) or can even be just an idea of how to deliver IT service on someone’s mind (e.g. a IT project manager or a senior IT architect).

We conclude that claim 23 is directed to a “paradigm” and thus is nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. *See In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009), *petition for cert. filed*, 77 U.S.L.W. 3680 (Jun. 20, 2009) (No. 80-1501) (“[E]ven if a claim may be deemed to fit literally within one or more of the statutory categories, it may not be patent eligible.”) “Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Id.* (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (internal quotation marks

omitted)). Because the recited “information technology service contract” is a mere meeting of the minds, the claimed “contract” is clearly directed to an abstract intellectual concept or mental process.

In addition, “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007) *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008). When the language of claim 23 is considered as a whole, we conclude that the claimed “technical framework” (an idea or a plan to perform IT service) falls outside the plainly expressed scope of § 101 (i.e., process, machine, manufacture, or composition of matter, or any new and useful improvement thereof), and thus, even though it may be new and useful, it is directed to non-statutory subject matter.

Claim 24

With respect to claim 24, the Examiner states that

The word “*for*” infers an intended use of the “*computer program product*”, as opposed to a positively recited embodiment. In other word, the claim does not necessitate that the “*computer program product*” be physically embodied on a “*computer readable medium*”. It is therefore directed to a program per se and not to a process occurring as a result of executing the program.

(Ans. 4).

The Appellants contend that “[a]s the preamble specifically states, the computer program product is for storage on a computer readable medium. There is no ambiguity.” (Reply 4). Further, the Appellants contend that the claim 24 as well as a computer readable medium can not be a “signal.” *Id.*

While claim 24 appears nominally directed to a "manufacture" under § 101 (as a computer program product), we agree with the Examiner that the express language of the claim does not preclude a reading of the recited “computer program product” on a disembodied computer program per se (which could be transmitted as a wireless signal), coupled with a statement of intended purpose regarding the “storage on a computer readable medium.” (Preamble, claim 24). We particularly note that no storage element is positively recited in the body of claim 24 to support the preamble. *Cf. Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (When the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”). “An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

Thus, we find the argued limitation “for storage on a computer readable medium” is a statement of an intended use that does not limit the

recited “computer program product” to actually being stored on a computer readable medium, nor does it affect the scope of the body of the claim which appears directed to steps of conducting the program. Therefore, we conclude that claim 24, although claiming “a computer program product,” broadly encompasses a computer program per se or a disembodied piece of software.

Software in itself, with no structural tie to an article of manufacture, machine, process or composition of matter, is not patentable subject matter. See *In re Nuijten*, 500 F.3d at 1357 (A claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101). Software (a computer program) alone does not belong to one of those categories.

This reasoning is applicable here. Therefore, while we agree with the Appellants’ contention that claim 24 is not literally directed to a signal claim, for the reasons discussed above, we agree with the Examiner’s interpretation of claim 24 as encompassing a computer program per se that is non-statutory under § 101.

Accordingly, we sustain the Examiner’s rejection of claims 23 and 24 under 35 U.S.C. § 101.

Nonstatutory Obviousness-type Double Patenting Rejection

With respect to claims 22-25, the Appellants contend that the Examiner has not made any factual inquiry as to determining the differences between the inventions claimed in the application and the claims in the cited

patent application. Therefore, the Examiner improperly rejected claims 22-25 under obviousness-type double patenting (App. Br. 12).

We agree with Appellants' contention. A double patenting rejection of the obviousness-type, if not based on an anticipation rationale, is analogous to the nonobviousness requirement of 35 U.S.C. § 103 except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594 (CCPA 1967).

Therefore, the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985). In the instant case, however, the Examiner has provided us with a conclusory statement that both claim 22 in the instant application and claims 1-15 of application 09/875,863 or claim 25-30 of copending application 09/875,865 contain similar critical concepts. The Examiner has not provided the required analysis to show how the rejected claims define subject matter that is an obvious variation of the subject matter of claims 1-15 or claims 25-30 of cited references.

Furthermore, the Examiner has not explained why and how one of ordinary skill in the art would have been led to the recited limitations such as "the solution scope guided by an information technology services contract with the customer." As such, the Examiner's conclusory statements about double patenting fail to make clear how the subject matter of pending claims 22-25 is patentably indistinct from the subject matter of patented claims 1-15 or 25-30 of the cited references. We, therefore, cannot sustain the obviousness-

type double patenting rejection.

35 U.S.C. § 102(e) Rejections

With respect to claim 22, the Appellants contend that the Hill reference does not disclose determining a solution scope for the technical framework to be created, nor is there any language in the cited passages that disclose the solution scope is guided by the service contract with the customer. (App. Br. 13). According to the Appellants, Hill does not determine the solution scope, but only discloses a hierarchical list to represent the IT infrastructure of the organization, in which each level corresponds to one of the element types of the organization, namely, organization, organization function, application, subsystem, or database (Reply Br. 6-7).

The Examiner states that “the hierarchical list(s) and graph(s) (i.e. ‘*solution scope*’) are generated by a program” that is used by the organization (i.e. customer). Therefore, the organization (i.e. ‘*customer*’) inherently has a service agreement to use that program (i.e. ‘*service contract*’).” (Ans. 13).

We disagree with the Examiner’s reading of the Hill reference. We find that Hill teaches a program for presenting the IT infrastructure of an organization that includes a hierarchical list and graph (FF 1). Although a solution scope of an IT framework may be represented as a hierarchical list and graph, the elements or components of the solution scope’s list and graph are the services which would be provided, and are generally not the elements

of IT infrastructure of the organization. We find nothing in Hill either inherently or expressly for mentioning or determining a solution scope guided by an IT service contract. Even if assuming the IT infrastructure is the solution scope of the IT service, the Examiner's inherency reasoning is still misplaced because the Hill's program may not be used by the organization (the user may be anyone who is interested to know the IT infrastructure of the organization), or the program may even be free software without any service contract needed. Hence, it is not necessarily present in Hill.

Because we agree with at least one of the Appellants' contentions, we find that the Examiner has not made a requisite showing of anticipation as required to disclose the invention as recited in claim 22. The rejection of the independent claims 23-25 contains the same noted deficiency.

Accordingly, we can not sustain the Examiner's anticipation rejection of claims 22-25.

VI. CONCLUSIONS

The Examiner did not err in concluding that the technical framework recited in claim 23 and a computer program product recited in claim 24 are not patent-eligible subject under 35 U.S.C. § 101.

The Examiner erred in rejecting claims 22-25 under nonstatutory obviousness-type patenting.

The Examiner erred in finding that Hill discloses the limitations "determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with

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the customer, the solution scope based on common practices for delivering certain types of information technology services” as recited in claim 22.

VII. ORDER

We reverse the anticipation rejections of claims 22-25 under 35 U.S.C. § 102.

We reverse the Examiner’s obviousness-type double patenting rejection on claims 22-25.

We affirm the Examiner’s rejection of claims 23 and 24 under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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